

REMARKS

With the addition of claim 29, claims 1 and 14-29 are pending in the above-referenced application and are submitted for the Examiner's reconsideration.

Claims 1, 14-15, 19-21, 24, and 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,240,363 to Theimer et al. ("Theimer"). Applicant submits that Theimer does not anticipate or suggest the invention as presented in the claims for at least the following reasons.

Claims 1, 24, and 26 are directed to a method and device for determining and outputting travel instructions for a travel route from a starting point to a destination, in which the travel route *and a sequence of instructions* is determined *by a central station*, and the sequence of the travel instructions is transmitted *from the central station to an arithmetic unit*. As explained in Applicant's response of July 3, 2003, Theimer fails to disclose a determination of a sequence of travel instructions by a central station, or a transmission of a sequence of travel instructions from a central station to an arithmetic unit. In particular, column 6, lines 4 through 12, of Theimer discusses an assignment of a driving instruction to each individual route node, but there is no suggestion of when this assignment occurs. It is clear from the overall context, however, in particular from column 5, lines 45 to 60, of Theimer which discuss the route transmission, that merely the route itself, without these assignments, is transmitted. Hence, the assignment of driving instructions to the route nodes can occur only in a processing unit in the vehicle. Accordingly, a determination and transmission of a sequence of travel instructions by a central station cannot be gathered from Theimer. Instead, Theimer teaches away from the present application in that a transmission of the driving route without driving instructions is disclosed, this driving route then still having to be evaluated subsequently.

The Office Action asserts that the central computer 14 and/or the base station 12 of Theimer determines a sequence of travel instructions, and that base station 12 transmits the sequence of travel instructions to the arithmetic unit 15. To support this assertion, the Office Action cites Figures 1-8, and column 4, lines 6-15, as well as column 4, line 66, to col. 6, line 24. However, it is respectfully submitted that broadly citing in excess of 100 lines of text, as well as each and every figure of the Theimer reference without further explanation, does not properly establish the Office Action's assertion, and that a more specific citation is required. In particular, Applicant respectfully requests that the Office indicate precisely where in the 100+ lines of cited text it is taught that the central computer determines a

sequence of travel instructions, and precisely where it is disclosed that sequence of travel instructions is transmitted from the central computer to the arithmetic unit. Indeed, it is respectfully submitted that the 100+ lines of cited text fail to support the Office Action's assertions with respect to the alleged actions of the central computer, as well as to the alleged transmissions from the central computer to the arithmetic unit.

As regards the anticipation rejection of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim limitation is contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). As explained above, it is respectfully submitted that the Office Action does not meet this standard, for example, as to the features of claims 1, 24, and 26, and that, at least for the reasons discussed herein, the reference relied upon would not enable a person having ordinary skill in the art to practice the subject matter of the claims 1, 24, and 26. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1, 24, and 26 under 35 U.S.C. § 102(e).

As for the remaining dependent claims 14-15, 19-21, and 28, Applicant respectfully submits that these claims are not anticipated by Theimer for at least the same reasons given in support of the patentability of claims 1, 24, or 26. In regards to claim 15, in particular, it is also respectfully submitted that column 3, lines 16 through 18 of Theimer that were cited by the Office Action merely point out that the display of the information is updated, and therefore a suggestion that a stored sequence of travel instructions is updated is not disclosed. Moreover, in regards to claims 21 and 28, it is also respectfully submitted that there is no suggestion by Theimer of a use of public transportation, that is, a suggestion to output driving instructions for the use of public transportation. Moreover still, in regards to claim 25, it is also respectfully submitted that there is no suggestion by Theimer as to what extent the navigational device is to be integrated in the vehicle.

Claims 16-18 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer. Applicant respectfully submits that claims 16-18 and 25 are patentable for at least the same reasons given above in support of the patentability of claim 1, from which claims 16-18 depend, and claim 24, from which claim 25 depends.

Moreover, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must describe or suggest each claim element and it must also provide a motivation or suggestion for modifying the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that a subjective “obvious to try” standard is not proper. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted). In short, there must be evidence of why a person having ordinary skill in the art would be motivated to modify a reference to provide the claimed subject matter of the claims.

As regards claim 16, in particular, the Office Action's assertion without further basis that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the system of Theimer [to] includes [sic] a memory unit to provide any desired travel instructions to the user” is mere hindsight reasoning and fails to demonstrate a requisite motivation to modify the Theimer reference to provide all of the features of claim 16, including the feature of “retrieving the travel instructions by the arithmetic unit using a publicly accessible operating device”, which the Office Action admits is not disclosed by Theimer.

As regards claims 17 and 18, in particular, the Office Action's assertion without further basis that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the system of Theimer [to] includes [sic] a fixed second arithmetic unit is [sic] in a personal computer for providing the same function as desired” is

mere hindsight reasoning and fails to demonstrate a requisite motivation to modify the Theimer reference to provide all of the features of claim 17, including the features of “planning the travel route by a fixed second arithmetic unit; transmitting the sequence of the travel instructions relating to the travel route to a central station; and retrieving the sequence of the travel instructions by the first arithmetic unit from the central station” or the features of claim 18, including “arranging the fixed second arithmetic unit in a personal computer”, which the Office Action admits is not disclosed by Theimer.

As regards claim 25, in particular, the Office Action’s assertion that “those skilled in the art should recognize that the arithmetic unit (15) must be located in or about in the car radio device so the driver may comfortable [sic] access the travel instructions” is mere hindsight reasoning and fails to demonstrate a requisite motivation to modify the Theimer reference to provide all of the features of claim 25, including the features of “the arithmetic unit arranged in a car radio device”, which the Office Action admits is not disclosed by Theimer. Specifically, Theimer does not provide any information as to what extent the navigational device mentioned there is to be integrated in the vehicle in any way. In particular, it is not taught to incorporate it specifically in a “car radio device.”

In sum, it is therefore respectfully submitted that claims 16-18 and 15 rejected as obvious are allowable over the reference relied upon for these further reasons.

Claims 22-23 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Theimer in view of U.S. Patent No. 5,825,283 to Camhi (“Camhi”). Applicant submits that claims 22-23 and 27 are patentable for at least the same reasons given in support of the patentability of claim 1, from which they depend. Moreover, the Office Action’s assertion that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the teaching of Camhi in the system of Theimer for providing rapid access to the user is assured any where in the world to receive any desired information” fails to demonstrate a requisite motivation to combine the references relied upon. Accordingly, it is respectfully submitted that claims 22-23 and 27 rejected as obvious are allowable over the references relied upon for these further reasons.

New claim 29 has been added. Support for claim 29 can be found at least on page 7, lines 22 to 25 of the Specification. Claim 29 depends from claim 1 and therefore includes all of the limitation of claim 1. Accordingly, claim 29 is allowable for at least the same reasons that claim 1 is allowable.

CONCLUSION

Applicant asserts that the present invention is new, non-obvious, and useful.
Consideration and allowance of the claims are requested.

Respectfully submitted,

KENYON & KENYON

By: *LG Magent (R. No. 41,172)*

Dated: 12/12/03

By: *Richard L. Mayer*

Richard L. Mayer

Reg. No. 22,490

One Broadway
New York, NY 10004
(212) 425-7200